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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Valerie De La Poterie

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/654,907	Applicant(s) DE LA POTERIE ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-24 and 79-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-24 and 79-107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/10/2009 has been entered.

Status of claims

Claims **10-11 have been cancelled** as per applicants' amendment dated 8/10/09. Claims 25-78 and 108-117 are withdrawn from consideration as being drawn to non-elected subject matter (election with traverse dated 1/11/07). Claims 1-9, 12-24 and 79-107 are currently examined in the application.

In view of limiting claim 1 to wax drawn to specific formula (I), rejection of claims 1-10, 12-24 and 79-107 under 112, first paragraph for lack of written description is hereby withdrawn. In view of the amendment, the rejection of claim 107 under 112, second paragraph is hereby withdrawn. In view of terminal disclaimer, which is approved, the rejection of claims 1-10, 12-24 and 79-107 under the grounds of nonstatutory obviousness-type double patenting rejection over claims 1-31 and 73-100 is hereby withdrawn.

The following rejection is maintained.

Claim Rejections - 35 USC § 112

Claims 1-10, 12-24 and 79-107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is limited to at least one wax of formula I, therefore claim 1 is unclear with respect to the expression “and further”.

Claims 2-9 are ambiguous and unclear since specification under paragraph [0161] describes Koster K82P which is within formula 1 having tack of 3.38 and harness value 0.96. What is the value of n for Koster K82P? Additionally does all the waxes within formula I meet the requirements of claims 2-9. Competent documentation which shows the tack value and harness value for all the waxes with n varying from 18-38 would be given careful consideration. Same is true also for claim 1 with respect to tack and hardness.

Example 10 drawn to elected subject matter has two types of wax. Therefore what is the difference between claims 15-24 and claims 97-100? Detailed explanation is requested

Claim Rejections - 35 USC § 103

Claims 1-24 and 79-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patents 5,985,298 ('298) and 5,783,176 ('176).

Patent '298 teaches cosmetic compositions. See col.5, ll 41-65 for mascara compositions and these compositions have wax. The compositions have volatile solvent and non-volatile oil, film former and emulsifier (surfactant claimed in claim 101). The waxes include Kester wax, which is also known as synthetic bees wax. Example 2 has bees wax and synthetic wax instead of synthetic bees wax. The example drawn to mascara has water (solvent). Patent also teaches

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other cosmetic compositions and this has ethyl alcohol (claims 79-84). The weight percent of the solvent is also within the claimed range. Mascara composition has film former, which is polyethylene. Example 2 has 4 types of waxes. Example 2 has carnauba wax and candelillia wax. The weight percent disclosed in example 2 is within the weight percent claimed. Example 2 has additional wax which is claimed in claims 97-100. The weight percent disclosed in example 2 is within the weight percent claimed. Patent also teaches other cosmetic compositions and this has ethyl alcohol (claims 79-84). The weight percent of the solvent is also within the claimed range. See also col.6, line 50 through col.7, line 32. Examples 1-5 do not have UV screening agent (claim 103). See all the examples drawn to various cosmetic formulations (claims 104-107). The combination of volatile oil and non volatile solvent belongs to claimed fatty phase. See col.2, line 20 through col.4, line 21 for fatty phase. See col.4, ll 48-50, col.5, ll 34-62. The weight percent of volatile solvent and non-volatile oil taught by the patent is within the weight percent claimed for the volatile oil and non-volatile oil (claims 85-92). See col. 4, ll 22-24 for the various cosmetic products. Patent also teaches film formers at paragraph bridging col.s 5-6 and teaches that various film formers disclosed in CTFA handbook can be used (claim 93). The difference between the patent and the instant application is patent does not disclose formula I claimed in claims 10-11 for tacky wax. However, patent '176 teaches tacky wax claimed in instant application as ester. See the abstract, see col.3, ll 30 through col.4, line 65 and see the paragraph bridging col.s 4-5. Patent at col.5, ll 35-45 teaches surfactants and at col.5, ll 52-61 teaches solvents and at col.8, ll 39-65 teaches conventional cosmetic additives. See the examples.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '298 and substitute synthetic bees was for

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bees wax or synthetic wax taught in the mascara compositions. One of ordinary skill in the art would substitute the functional equivalents expecting that the synthetic bees wax can also be used in composition. With respect to claims 10-11, one of ordinary skill in the art would substitute the synthetic beeswax of patent '298 to ester of patent '176 (claimed in instant application as tacky wax and also known as synthetic wax since INCI name for Kester wax is synthetic bees wax) . One of ordinary skill in the art would substitute the functional equivalents expecting that the ester of patent '176 (INCI name is synthetic bees wax) can also be used in composition. This is a prima facie case of obviousness.

Response to Arguments

Applicant's arguments filed 8/10/09 have been fully considered but they are not persuasive.

Applicants' acknowledged that patent '298 broadly discloses compositions having 1-30 % wax but argue that example 2 cited by office discloses only 22.95% wax and patent '136 teaches wax content of 15-25 % by weight and one of ordinary skill in the art would have been motivated to prepare compositions within the range of 15-25% given the example 2 of patent '298 is within this range.

In response to the above argument, patent '298 is not only valid for example 2 but also for the entire disclosure. Patent '298 teaches waxes in cosmetic compositions and the weight percent is 0.1-30% wax and the claimed wax of at least 27% is within the weight percent of wax taught by patent '298 and example 2 teaches synthetic wax but not the synthetic bees wax since Kester wax taught by specification as tacky wax has the INCI name synthetic bees wax and patent '176 teaches tacky wax claimed in instant application as ester and one of ordinary skill in

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the art would prepare compositions of patent '298 and substitute bees wax or synthetic wax taught in the mascara compositions of patent '298 with tacky wax of patent '176 (INCI name synthetic bees wax) expecting predictable results. Therefore differences in weight percent of wax will not support the patentability of subject matter encompassed by patent '298 unless there is evidence indicating such weight percent claimed is critical. *[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to disclose the optimum or routine experimentation. In re Aller, 105 USPQ 233, 235.*

Applicants' also argue that office provides no reason why one of skill in the art at the time of the invention would have selected the specific compound(s) of formula (I), according to the instant claims, out of all the tacky waxes known in the art rather, the office uses impermissible hindsight, simply arguing that the ester of '176 and patent '278 wax are "functional equivalents" and the instant application destroys a "functional equivalents" argument. In particular, comparative Example 2 contains beeswax (i.e., certain wax of Brieva) whereas inventive Example 1 contains a wax of the specific formula (I) as claimed (i.e., certain wax of Meiring). The results demonstrate that Example 1 has a better combination of physical properties (e.g., stability, viscosity, and consistency) compared with Example 2 (as well as four other compositions containing waxes falling outside the scope of the claims). See Specification as-filed at ¶¶[0184]-[0193]. Accordingly, the different results show that these waxes are not "functional equivalents" as the Office alleges.

In response to the above argument, patent '176 at col.3, ll 4-17 teaches the disadvantages of using oils and waxes in cosmetic formulations and patent '176 teaches claimed wax as a base for cosmetic sticks and teaches at col.4, ll 20-25 the advantages of using the ester (claimed in the

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instant application as tacky wax). Patent does not teach the ester having tacky properties, however the compound and its properties are inseparable (emphasis added). The advantages of using claimed wax taught by patent '176 are:

1. It can be used as a base in cosmetic sticks
2. It can be used in anhydrous form and also W/O emulsions
3. These waxes have high heat-stability, excellent adhesion and very good use properties.

Therefore one of ordinary skill in the cosmetic art would use the ester of patent '176 in cosmetic formulations of patent '298 since patent '176 teaches the disadvantages of using conventional paraffin wax and other waxes.

In response to applicants' argument with respect to example 1 and comparative example 2 *none of the independent claims are limited to anhydrous mascara using specific ingredients of example 1 which show combination of physical properties. Therefore 103 rejection is deemed proper.*

See below for advancing the prosecution with respect applicants' arguments regarding example 1 of instant application and comparative example 2.

Application is in condition for allowance subjecting to the following amendments.

1. Amending claim 1 to "anhydrous mascara composition" and deleting tack and hardness value and deleting "and further" in claim 1.
2. Cancelling claims 2-9, 12, 15-24, 79-87, 89-94, 97-101 and 103-107.
3. Incorporating limitation of claims 12 into claim 1, incorporating isododecane as volatile oil and incorporating claim 87 into claim 1, incorporating claims 93-94 into claim 1 and incorporating claim 103 into claim 1.

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4. Cancelling non-elected claims

5. Requesting rejoinder and if the claims are rejoined, then the method of use claim to depend on claim1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, EYLER YVONNE (BONNIE) can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619